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| 03/18/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/798,109

Applicant(s)

MEYER, HERMANN

Examiner

BRANON C. PAINTER

Art Unit

3633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 2,10,11 and 13 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28 is/are allowed.
- 6) ☒ Claim(s) 1,3-7,12,14-20,22-27 and 29 is/are rejected.
- 7) ☒ Claim(s) 8,9 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 05/19/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 1, 27, and 29 are objected to due to the phrase "the first axial partial section." For the purposes of this examination, the examiner presumes this phrase should be written "the first axial section."
2. Claims 3 and 23 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitations of these claims serve to modify "the body." However, in claim 1 a body is never positively claimed. Although applicant has amended claim 1 to read "a tubular element connectable to a body," the phrase fails to positively claim a body, and instead only claims a tubular element capable of being connected to a body. For the purpose of this examination, the examiner presumes that "the body" refers to "drive shaft" in Fig. 1.
3. Claims 12 and 24 are objected to as they depend from cancelled claim 10. Appropriate correction is required.
4. Claims 14-15 and 25 are objected to as they depend from cancelled claim 13. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

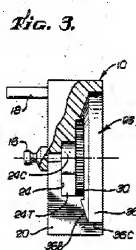
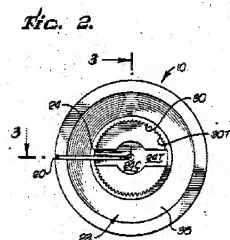
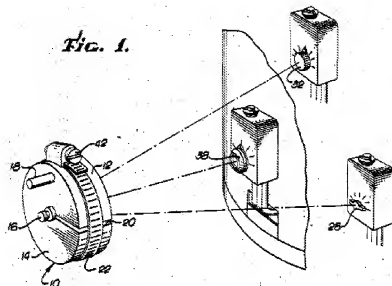
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4-7, 16-20, 26-27, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Stansbury, Jr. et al. (U.S. Patent No. 4,692,051).
7. Regarding claims 1 and 29, Stansbury, Jr. et al. discloses an adapter having all of the applicant's claimed structure, including:

An arrangement comprising a tubular element ("knob" 32, Fig. 1) connectable to a body extending into the tubular element (a shaft inherently must extend from the box to the knobs in Fig. 1, as the device is analog, not digital), and a tension ring ("cylindrical body" 12, Fig. 1) adapted to embrace, by an inner surface ("inner portion" 23, Fig. 2), an outer wall at an end of the tubular element, the tension ring adapted to extend axially along the tubular element and adapted to apply a clamp force to the tubular element (via "clamp" 22, Fig. 1) so that the tubular element acts via an inner wall of the tubular element on the body extending into the tubular element to clamp the tubular element on the body; wherein the tension ring includes a first axial section (from "outer portion" 14 through "serrated ring" 30, Fig. 1,3) and a second axial section ("frosto-conical portion" 36B, Fig. 3) contiguous in axial direction to the first axial section and is adapted to rest by only the first axial partial section of the inner surface ("serrated ring" 30, Fig. 2) against the outer wall of the tubular element ("knob" 32, Fig. 1) and is adapted to exert a clamp action on the

Art Unit: 3633

outer wall of the tubular element; wherein at the end, a wall of the tubular element on which the tension ring is to be positioned includes a smaller thickness than a contiguous axial region of the tubular element (The base of "knob" 32 includes an arrow that points to the temperature demarcations. At that base point the arrow and knob are thicker than the knob is at the outer facing end, Fig. 1); wherein the first axial section is configured to face an end face of the end of the tubular element.



Reproduced from U.S. Patent No. 4,692,051

8. The examiner notes that claim scope is not limited by claim language such as "adapted to," which suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. See MPEP 2111.04.

9. The examiner further notes that if the claim language were altered to remove the "adapted to" language, Stansbury, Jr. et al. would still read on the claim as shown by the parallels drawn above between Stansbury, Jr. et al. and applicant.
10. Regarding claim 4, Stansbury, Jr. et al. discloses a second axial section that does not rest against the tubular element ("frosto-conical portion" 36B, Fig. 3).
11. Regarding claim 5, Stansbury, Jr. et al. discloses a second axial section that is axially thicker than the first axial section (Fig. 3).
12. Regarding claims 6 and 7, Stansbury, Jr. et al. discloses a second axial section farther from the center axis than the first axial section (second axial section "frosto-conical portion" 36B, Fig. 3) with a cut-out in the second axial section ("frosto-conical portion" 36B, Fig. 3).
13. Regarding claim 16, Stansbury, Jr. et al. discloses a tension ring with a plurality of clamp points along the inner circumference of the ring to rest against the tubular element ("serrated ring" 30, Fig. 2).
14. Regarding claim 17, Stansbury, Jr. et al. discloses an inner surface with three clamp points ("serrated ring" 30, Fig. 2).
15. Regarding claim 18, Stansbury, Jr. et al. discloses a tension ring with integrally molded protrusions ("serrated ring" 30, Fig. 2). The examiner notes that claim 18 is considered to be a product-by-process claim due to the phrase "molded." The patentability of the product does not depend on its method of production. Determination of patentability is based on the product itself. See MPEP 2113. If the product in the product-by-process claim is the same as or obvious from a

product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

16. Regarding claim 19, Stansbury, Jr. et al. discloses equidistant clamp points on the tension ring ("serrated ring" 30, Fig. 2).
17. Regarding claim 20, Stansbury, Jr. et al. discloses a weak point between each two adjacent clamp points (valleys in "serration ring" 30, Fig. 2).
18. Regarding claim 26, Stansbury, Jr. et al. discloses a weak spot adapted to act as a joint (valleys in "serration ring" 30, Fig. 2).
19. Regarding claim 27, Stansbury, Jr. et al. discloses an adapter having all of the applicant's claimed structure as discussed with regard to claim 1.
20. Claims 1, 3, and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Stansbury, Jr. et al. (U.S. Patent No. 4,692,051).
21. Regarding claim 1, Stansbury, Jr. et al. discloses an adapter having all of the applicant's claimed structure, including:
An arrangement comprising a tubular element ("cylindrical body" 12, Fig. 1) connectable to a body extending into the tubular element ("knob" 32, Fig. 1), and a tension ring ("clamp" 22, Fig. 1) adapted to embrace, by an inner surface ("inner portion" 23, Fig. 2), an outer wall at an end of the tubular element, the tension ring adapted to extend axially along the tubular element and adapted to apply a clamp force to the tubular element so that the tubular element acts via an inner wall of the tubular element on the body extending into the tubular element to clamp the tubular

element on the body; wherein the tension ring includes a first axial section and a second axial section contiguous in axial direction to the first axial section and is adapted to rest by only the first axial partial section of the inner surface ("clamp" 22 is capable of resting with only a partial section in contact with "cylindrical body" 12, Fig. 1) against the outer wall of the tubular element ("cylindrical body" 12, Fig. 1) and is adapted to exert a clamp action on the outer wall of the tubular element; wherein at the end, a wall of the tubular element on which the tension ring is to be positioned includes a smaller thickness than a contiguous axial region of the tubular element (the thickness at "body" 12 is greater than the thickness at "pivot point" 16, Fig. 1); wherein the first axial section is configured to face an end face of the end of the tubular element.

22. Regarding claim 3, Stansbury, Jr. et al. discloses a body including a cylindrical element ("knob" 32, Fig. 1).
23. Regarding claim 22, Stansbury, Jr. et al. discloses a tubular element with a hollow shaft ("cylindrical body" 12 acts as shaft with hollow portion "hollow cylinder" 24C, Fig. 2).
24. Regarding claim 23, Stansbury, Jr. et al. discloses a body including a drive shaft ("knob" 32 acts as a drive shaft as it transmits mechanical power when rotated, Fig. 2).
25. Claims 1, 12, 14-15, and 24-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Stansbury, Jr. et al. (U.S. Patent No. 4,692,051).

26. Regarding claim 1, Stansbury, Jr. et al. discloses an adapter having all of the applicant's claimed structure as set forth above, with the exceptions that the following are represented by different parts: tubular element ("knob" 38, Fig. 1) and first axial region ("frosto-conical portion" 36B, Fig. 2). The examiner notes that, as with "knob" 32, "knob" 36 includes an arrow indicator at the base that is thicker in diameter than the knob body, as well as the fact that the body of "knob" 36 tapers as it approaches its outermost end, meeting the added limitations of claim 1.
27. Regarding claim 4, Stansbury, Jr. et al. discloses Stansbury, Jr. et al. discloses a second axial section ("cylindrical portion" 36C, Fig. 2).
28. Regarding claim 12, Stansbury, Jr. et al. discloses a projection on the end face of the unattached end of the tubular element (raised projecting portion on outer face of "knob" 38, Fig. 1).
29. Regarding claim 14, Stansbury, Jr. et al. discloses a shoulder transitioning between the unattached end to the contiguous axial region (beveled region between raised projecting portion and base portion of "knob" 38, Fig. 1).
30. Regarding claim 15, Stansbury, Jr. et al. discloses a tension ring positionable in an axial position directly next to the shoulder ("cylindrical body" 12, Fig. 1).
31. Regarding claim 24, Stansbury, Jr. et al. discloses an outwardly protruding projection arranged as a circumferential flange (raised projecting portion on outer face of "knob" 38, Fig. 1).
32. Regarding claim 25, Stansbury, Jr. et al. discloses a tension ring restable against the shoulder ("cylindrical body" 12, Fig. 1).

Allowable Subject Matter

33. Claim 28 is allowed.
34. Claims 8-9 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

35. Applicant's arguments filed 12/20/07 have been fully considered but they are not persuasive.
36. Applicant argues that "there is no indication whatsoever by Stansbury that cylinder 12...is adapted to apply a clamp force to the knob 32 so that the knob 32 acts via an inner wall of the knob 32 on a body extending into the knob 32 to clamp the knob 32." However, as discussed in the rejection above, Stansbury does disclose these elements. Stansbury teaches an analog system for adjusting temperature. The examiner notes again that because the system is analog, it must include a series of parts that are physically connected to one another. As with any other analog temperature control, a shaft is inherently present and extending into the body of "knob" 32/38, since the system would be inoperable without said shaft. Physically rotating "body" 12 causes the temperature to increase or decrease. A slip-free connection between "body" 12 (applicant's tension ring) and "knob" 32/38 (applicant's tubular element) is achieved by tightening "tension ring clamp" 22,

which causes "body" 12 to apply a clamp force to "knob" 32/38. This clamp force, in turn, causes "knob" 32/38 to act via an inner wall to clamp onto the shaft (applicant's body) extending into "knob" 32/38, allowing the rotation of "body" 12 to cause the slip-free rotation of both "knob" 32/38 and the shaft.

37. Applicant argues a blanket statement that Stansbury does not teach disclose or suggest any of the features added in the amendment. However, Stansbury does disclose these features as detailed in the rejection above.

Conclusion

38. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
39. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3633

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANON C. PAINTER whose telephone number is (571)270-3110. The examiner can normally be reached on Mon-Fri 7:30AM-5:00PM, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on (571) 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. C. P./
Examiner, Art Unit 3633
03/05/08

/Brian E. Glessner/
Supervisory Patent Examiner, Art Unit 3633